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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/440,467	11/15/1999	JUN YOSHIDA	35.C14025	3001

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EXAMINER

AKHAVANNIK, HUSSEIN

ART UNIT

PAPER NUMBER

2621

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.	Applicant(s)	
09/440,467	YOSHIDA ET AL.	
Examiner	Art Unit	
Hussein Akhavannik	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 7-11 and 14-27 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 6, 12-13 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11-15-99 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on 3-17-00 is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) Interview Summary (PTO-413) Paper No(s). 7.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I in Paper No. 6 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 14-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Groups II-IV, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 6.

2. During a telephone conversation with Attorney Brian Klock on November 6, 2002, a provisional election was made without traverse to prosecute the invention of Group 1, Species 5, claims 1, 6, 12, and 13. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-5 and 7-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Drawings***

3. The drawings are objected to because:

Figure 10, reference number 2202, "injustice detecting device should be changed to "illegality detecting device" to correspond to the specification.

Figure 24, reference number 1601, "injustice detecting device should be changed to "illegality detecting device" to correspond to the specification.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6, and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (U.S. Patent No. 6,115,818) in view of Rhoads (U.S. Patent No. 6,449,377).

Referring to claims 1, 12, and 13, a detection means for detecting whether an illegal process has been performed for input digital contents based on a result obtained by performing a predetermined operation for at least part of the digital contents is explained by Barton in column 8, lines 25-35. The predetermined process of comparing the signatures determines whether the embedded data string has been tampered with.

Performing a predetermined process for the digital contents when an illegal process has been detected is not explained by Barton. However, Rhoads explains the predetermined process of inserting tracer data into the image of a banknote when copying a banknote is detected in column 8, lines 30-40. Such a tracer data would allow authorities to trace the location, date, and/or time that the illegal process took place. Furthermore, data can be embedded to inform a system to halt any process which involves data, which has had an illegal process, associated with it. Because the data of Barton and Rhoads are both in digital form when being checked for

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illegal processes, it would be simple to one of ordinary skill in the art to add either visible or invisible data. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to perform a predetermined process when an illegal process that been detected so that the illegal process can be halted or traced.

The result of the predetermined operation indicating whether a digital watermark has been correctly embedded and judging that an illegal process has been performed when the watermark is not correctly embedded is explained by Barton in column 8, lines 25-35. If the signature were correctly embedded then the signatures would match. If the signatures do not match then, the file is determined to have been tampered with.

Referring to claim 6, processing means for adding visible or invisible information to the digital data is not explained by Barton. However, Rhoads does explain adding digital data to the copy in column 8, lines 30-40. It would have been obvious to one of ordinary skill in the art at the time the invention was made to embed either visible or invisible data in input data on which an illegal process had been performed to trace or stop the illegal process.

### *Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Suzuki et al (U.S. Patent No. 5,216,724) – To exhibit embedding digital information when a document that contains a watermark is recognized.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hussein Akhavannik whose telephone number is (703)306-4049. The examiner can normally be reached on M-F 8:30-5:00.

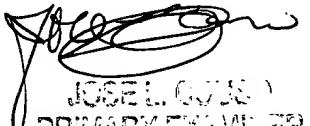
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H. Boudreau can be reached on (703)305-4706. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9314 for regular communications and (703)872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Hussein Akhavannik  
November 7, 2002

H.A.



JOSÉ L. GUZMÁN  
PRIMARY EXAMINER